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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,671	08/08/2006	Ulrich Riegel	29827/42222	9953
4743 7590 08/04/2010 MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE 6300 WILLIS TOWER CHICAGO, IL 60606-6357			EXAMINER RABAGO, ROBERTO	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 08/04/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/588,671

**Applicant(s)**

RIEGEL ET AL.

**Examiner**

Roberto Rabago

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 13 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11, 13 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 1-9, 11, 13, 15-20 drawn to an invention nonelected with traverse in the reply filed on 11/3/2009. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC 103***

2. Claims 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frenz et al. (US 2002/0128618) in view of Hermeling et al. (US 2004/0265387) for the reasons set forth in item 5 of the Office action mailed 1/21/2010.

Regarding new claims 28 and 29, the cited reference example is within the newly claimed ranges. It is noted that the prior rejection incorrectly indicated that the exemplified concentration of organic crosslinking agent was 0.01 wt%; the correct value is 0.1 wt%. Regarding new claim 27, the reference does not appear to have used a deagglomeration assistant in the amount stated in the product-by-process portion of the claim. However, the final product is not required to include any of this component, and the record contains no basis to conclude that the reference product would be outside the broad scope of the claims.

Applicants' arguments filed 5/17/2010 have been fully considered but they are not persuasive. Applicants argue that there is no incentive to reduce the particle size

because SFC would be adversely affected. However, SFC is not the only factor to be optimized in the method of Frenz. Rather, as stated in [0014]: ***It is an object of the present invention to provide highly swellable hydrogels or water-absorbent compositions having good transportation properties and high permeability coupled with high ultimate absorption capacity and a high swell rate when used in hygienic articles.*** Clearly, while transportation properties should be "good", the apparently more important parameters are absorption capacity and swell rate. Since it is furthermore stated in [0013] that SFC and swell rate are inversely related, the reference clearly appreciates that these two factors must be balanced. In contrast, applicants' implication that the only factor of significance is SFC, finds no support in the reference. As shown in [0021] of Hermeling, PUP increases as particle size decreases, yet the composition still maintains SFC which far exceeds the range stated in Frenz as within the scope of the invention (i.e., preferably at least 60 cm<sup>3</sup>s/g). Accordingly, it would be obvious to classify the product of Frenz to exclude at least the largest size fraction described in Hermeling (i.e., the fraction at 500-710 micrometers) because this step would achieve improvements in both absorption capacity and swell rate, while still maintaining values of SFC which far exceed the minimum preferred values stated in Frenz. Because such a simple and conventional step would advance the objects of the invention stated in Frenz, one of ordinary skill in the art would be motivated to classify the product to remove at least the largest size fraction.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rabago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rabago/  
Primary Examiner  
Art Unit 1796

July 31, 2010